



FEB 28 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Micheline Gravelle
BERESKIN & PARR
Box 401, 40 King Street West
Toronto, Ontario
Canada M5H 3Y2

In re Application of :
WARRINGTON, R. C. *et al* :
Application No.: 09/600,125 :
PCT No.: PCT/CA99/00005 :
Int. Filing Date: 13 January 1999 :
Priority Date: 13 January 1998 :
Attorney Docket No.: 10242-32 :
For: COMPOSITION CONTAINING :
PROPARGYLAMINE FOR ENHANCING :
CANCER THERAPY :

DECISION

This is a decision on the papers filed 02 January 2001 requesting the United States Patent and Trademark Office (PTO) accept the declaration signed by the legal representative of a deceased co-inventor.

BACKGROUND

On 13 January 1999, applicants filed international application PCT/CA99/00005 claiming priority to a Canadian patent application filed 13 January 1998. A copy of the international application was communicated from the International Bureau to the United States Patent and Trademark Office on 22 July 1999.

On 13 August 1999, a Demand was filed with the International Preliminary Examination Authority electing the United States. The election was made prior to the expiration of 19 months from the priority date. Accordingly, the deadline for submission of a copy of the international application and payment of the basic national fee was extended to expire thirty months from the priority date, *i.e.*, 13 July 2000.

On 12 July 2000, applicants filed a transmittal letter for entry into the national stage in the United States under 35 U.S.C. 371 which was accompanied by, *inter alia*, a check of \$910.00 to pay the basic national fee; and authorization to charge Counsel's Deposit Account No. 02-2095 for any additional fees as required.

On 26 October 2000, a NOTIFICATION OF MISSING REQUIREMENTS (Form PCT/DO/EO/905) was mailed indicating that a declaration in compliance with 37 CFR 1.497(a) & (b) and a surcharge pursuant to 37 CFR 1.492(e) was required. A one month time limit was set for response.

On 02 January 2001, applicants submitted the instant response which was accompanied by, *inter alia*, a one-month extension and fee, the required surcharge fee, a copy of the "Letters Probate," and a copy of the "Last Will" of Ian Alick Paterson.

DISCUSSION

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

In the instant petition, applicants have furnished a declaration signed by two of the three co-inventors, R.C. Warrington and Alan A. Boulton, and by "Canada Trust" as legal representative of I. Alick Paterson. However, applicants have not provided the name, citizenship, residence, and last post office address of the deceased inventor as required pursuant to 37 CFR 1.497.

Also, it appears that two persons signed for the legal representative, Canada Trust, however, the names of these persons are not listed and their signatures are illegible. In addition, the position of "Senior Trust Officer" and "Estate Counsellor," are positions not normally associated with having the authority to sign for a corporation and there is no statement claiming that these persons have the requisite authority to sign for Canada Trust. Such an express declaration by each agent is required.

Accordingly, the declaration is not acceptable under 37 CFR 1.42.

Applicants also included a copy of the "Letters Probate," and a copy of the "Last Will" of Ian Alick Paterson" presumably as the proof of the authority under 37 CFR 1.44 of Canada Trust to sign as the legal representative of the deceased inventor. It is noted that proof of the authority of the legal representative in compliance with 37 CFR 1.44 is no longer required in the USPTO as of 08 September 2000.

CONCLUSION

Applicants' request Under 37 CFR 1.42 is **DISMISSED** without prejudice.

If reconsideration of this decision is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.42". Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.


Boris Milef
PCT Legal Examiner
PCT Legal Office


James Thomson
PCT Legal Attorney
PCT Legal Office

Tel.: (703) 308-6457